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Docket No. OB-189

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Braun et al.

Serial Number: 09/634,087

Filed: 08/08/00

) For: Oral Care Devices

) Group Art Unit: 1744

) Examiner: Spisich, M.

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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VA 22313-1450

TRANSMITTAL

1. Transmitted herewith are the following documents for the above-identified application:
  - (a) Appeal Brief (in triplicate)
2. A **zero** month extension of time is requested (or such extension as required to make the enclosed documents timely).
3. The Commissioner is hereby authorized to charge the Appeal Brief fee of **\$330**, plus any other fees required by this communication, including extension fees, to Deposit Account No. **07-1350**. A duplicate copy of this authorization is enclosed.

Respectfully submitted,

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CERTIFICATE OF MAILING (37 CFR 1.8)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

April 22, 2004  
Date

Janice Underm



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**APPEAL BRIEF**

This is an appeal of the Final Rejection mailed on 11/17/03, as modified by the Advisory Action mailed on 3/10/04. A Notice of Appeal was timely filed on 2/17/04.

Real Party in Interest

This application is assigned to Gillette Canada Company, a Nova Scotia corporation that is indirectly wholly owned by The Gillette Company. The real party in interest is The Gillette Company.

Related Appeals and Interferences

There are no related appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of Claims

The claims under appeal are claims 1, 3, 7-17, 22-23, 43 and 44. A copy of these claims is set forth in the attached Appendix.

Status of Amendments

The Amendment filed on 2/17/04 was not entered as indicated in the Advisory Action of 3/10/04.

Summary of the Invention

The invention relates to an oral care device 19 having a body 12 defining a longitudinal axis having a head 16 shaped for insertion into the oral cavity. A rocking element 20 is mounted

on the head. The rocking element includes a central portion 30 and a plurality of protrusions 31 extending radially from the central portion along the longitudinal axis of the body. The protrusions taper from a relatively wide base 34 to a relatively narrow tip 32. The tips are shaped to penetrate the interproximal and subgingival regions of the oral cavity. See Figs. 1-3B and page 3, line 27 to page 4 line 21.

The invention further relates to an oral care device 19 having a body 12 defining a longitudinal axis having a head 16 shaped for insertion into the oral cavity. A rocking element 20 is mounted on the head. The rocking element includes a central portion 30 and a plurality of protrusions 31 extending radially from the central portion along the longitudinal axis of the oral care device. The protrusions include side surfaces 36 that define an arc having a radius of curvature from about 0.150 to 0.175. . See Figs. 1-3B and page 3, line 27 to page 4 line 30.

### Issues

1. Whether claims 1, 3, 17, 22, 43 and 44 are anticipated under 35 USC §102(b) by Thomas et al (USP 2,246,867)?
2. Whether claims 1, 3, 22, 23, 43 and 44 are anticipated under 35 USC §102(b) by Birch (USP 3,230,562)?
3. Whether claims 7-16 are unpatentable under 35 USC §103(a) as being obvious over Birch?
4. Whether claims 1, 3, 7-16, 22, 23, 43 and 44 are unpatentable under 35 USC §103(a) as being obvious over Mark (USP 4,403,623) in view of Birch?

### Grouping of Claims

For Issue 1, claims 1, 3 and 22 stand or fall together, claim 17 stands or falls on its own, claim 43 stands or falls on its own, and claim 44 stands or falls on its own. For Issue 2, claims 1, 3, 22 and 23 stand or fall together, claim 43 stands or falls on its own, and claim 44 stands or falls on its own. For Issue 3 each of claims 7, 15 and 16 stand or fall together, and each of claims 8-14 stands or falls on its own. For Issue 4, claims 1, 3, 7, 15-16, 22 and 23 stand or fall together, and each of claims 8-14, 43 and 44 stands or falls on its own. Arguments pertaining to the separate patentability of the dependent claims are included in the arguments below.

## ARGUMENT

The Examiner indicated in the advisory Action mailed 3/10/04 that the rejections under 35 USC 112, second paragraph have been overcome. Further, Applicants have decided not to appeal the rejections of claim 21 under 35 USC 103(a).

Issue 1: Claims 1, 3, 17, 22, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,246,867 to Thomas ("Thomas"). Thomas discloses a toothbrush that includes a combined buffing and massaging element, which is formed of rubber or other soft, flexible and preferably elastic material. The arcuate face of the element is provided with small transversely disposed ribs or corrugations. Claim 1 features an oral care device including a body and a rocking element that includes a plurality of protrusions extending radially therefrom. The protrusions are further defined both structurally, i.e., the protrusions taper from a relatively wide base to a relatively narrow tip, and functionally, i.e., the protrusions are shaped to penetrate the interproximal and subgingival regions of the oral cavity. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art and in the context in which it is used. (See M.P.E.P. §2173.05(g).)

Applicants have disclosed the relationship of the shape of the protrusions to the function of penetrating the interproximal and subgingival regions. This relationship is shown in Figures 3, 3A, and 3B and discussed on page 4, lines 19-23 of Applicant's specification as follows:

"(b)ecause the tips 32 are relatively thin, as the rocking element 20 passes over the teeth, the tips 32 will penetrate into the interproximal regions. Side surfaces 35 will rub against and clean the teeth in the interproximal region, and face surface 33 will tend to contact the gums, resulting in massaging and cleaning of the supragingival area." (Emphasis added.)

The phrase "shaped to penetrate the interproximal and subgingival regions of the oral cavity," when read in the context of the specification and the figures, conveys a structure including protrusions that are long enough, thin enough, rigid enough, and positioned to enter the interproximal region of the users teeth.

In contrast, one of skill in the art reading Thomas would understand, based on the text and figures of Thomas, that the oral care device disclosed in Thomas does not include a feature that would penetrate the interproximal regions of the user's teeth. Rather, one of skill in the art reading

Thomas would understand that the rocking member featured in Thomas would engage the teeth with rubbing contact, thus more effectively polishing the teeth, and also applying helpful massage to the gums. (See Thomas Col. 1, lines 13-27.) In view of the foregoing, Applicants assert that Thomas fails to teach each element recited in claim 1 and its dependent claims, and requests that the corresponding rejection be withdrawn.

Claim 17 depends from claim 1 and further calls for the central portion to include an opening therethrough sized to allow the rocking element to conform to a tooth's shape during use.

Thomas makes no such disclosure and so cannot anticipate claim 17.

Claims 43 and 44 feature an oral care device having a rocking element with protrusions extending along the longitudinal axis of the oral care device. The protrusions include side surfaces that define an arc having a radius of curvature from about 0.150 to 0.175. Thomas does not teach or suggest protrusion having side surfaces defining an arc that has a radius of curvature from about 0.150 to 0.175. Accordingly, Applicants assert that claims 43 and 44 are novel over Thomas.

Issue 2: Claims 1, 3, 22, 23, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,230,562 to Birch ("Birch"). Birch discloses an oral care device that includes one or more gum massaging means in combination with a toothbrush. Birch does not teach or suggest an oral care device that includes a rocking element having a central portion and a plurality of protrusions extending radially therefrom along the longitudinal axis of the body of the oral care device as called for in all of claims 1, 3, 22, 23, 43 and 44. Birch does disclose massaging means that include a plurality of tips secured to a body, which is then secured to the base of an oral care device. However, in each instance where Birch discloses massaging means the plurality of tips extend from the body along the horizontal axis of the toothbrush. (See e.g., Figs. 1, 2, 3, 4, 8, 9, 10, 11, and 12.) Accordingly, Birch fails to teach each element of these claims, and thus does not anticipate these claims. In view of the foregoing, Applicants request that the rejection be withdrawn.

Claims 43 and 44 feature an oral care device having a rocking element with protrusions extending along the longitudinal axis of the oral care device. The protrusions include side surfaces that define an arc having a radius of curvature from about 0.150 to 0.175. Birch does not teach or suggest protrusion having side surfaces defining an arc that has a radius of curvature

from about 0.150 to 0.175. Accordingly, Applicants assert that claims 43 and 44 are novel over Birch.

Issue 3: Claims 7-16 are rejected as being unpatentable under 35 USC §103(a) in view of Birch. Each of claims 7-16 depend from claim 1 and are therefore patentable for at least the reasons provided above for Issue 2. That is that Birch does not teach or suggest a plurality of protrusions extending radially therefrom along the longitudinal axis of the body of the oral care device. Accordingly, claims 7-16 are not obvious in view of Birch.

Further, claim 8 calls for the tips of the protrusions to have a width of from about 0.005 to 0.025 inches. Claim 9 calls for the rocking element to have a thickness of less than 0.200 inches. Claim 10 calls for the rocking element to have a thickness of from 0.050 to 0.125 inches. Claim 11 calls for the rocking element to have a thickness of from 0.080 to 0.100 inches. Claim 12 calls for the rocking element to have an overall diameter less than 1.000 inches. Claim 13 calls for the rocking element to have an overall diameter of from 0.500 to 0.700 inches. Claim 14 calls for the rocking element to have an overall diameter of from 0.550 to 0.650 inches. Birch does not teach or suggest any of these features. Accordingly, claims 8-14 are not obvious in view of Birch.

Issue 4: Claims 1, 3, 7-16, 22, 23, 43 and 44 are rejected as unpatentable under 35 USC §103(a) for being obvious over Mark (USP 4,403,623) in view of Birch. The Examiner has not pointed out where in either of these references there is a teaching or suggestion that would motivate one skilled in the art to combine the teachings of the references as suggested by the Examiner to arrive at applicants invention. The Examiner merely states that "...it is shown by the art to be an art-recognized equivalent structure for brushing and massaging."

**A prima facie case of obviousness has not been established by the selective combination of isolated teachings from references where there is no suggestion or motivation to combine those teachings in the manner asserted, nor any indication of the result that might be achieved by such a combination.**

The CAFC has set forth a number of guidelines for a proper analysis under 35 USC §103. The test for obviousness is not whether particular elements or ingredients are known, but whether the claimed invention as a whole is suggested by the cited references. *Hartness Int'l., v. Simplimatic Eng'g Co.*, 2 USPQ2d 1826 (Fed. Cir. 1987). Moreover, before references can be combined there must be some teaching or suggestion to do so. *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Geiger*, 2 USPQ2d 1276 (Fed. Cir. 1987). The mere fact that references originate in the same art

does not provide a suggestion to combine them. *In re Levitt*, 11 USPQ2d 1315 (Fed. Cir. 1989, unpublished). In addition, the fact that the prior art could be modified does not make the modification obvious unless the prior art also suggests the desirability of making the modification. *In re Mills*, 15 USPQ2d 1430 (Fed. Cir. 1990). Both the suggestion to make the claimed composition and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). The sufficiency of the teachings of the secondary references must be examined under the aforementioned guidelines.

It appears that the Examiner has improperly employed hindsight by using appellants' disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. *Grain Processing Corp. v. American Maize-Products Co.*, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). While each component of the claimed composition may be known, what is not known or suggested is "the composition that resulted from the combination of those components, and its unique properties". *The Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d 1923, 1928 (Fed. Cir. 1990). Accordingly appellants respectfully urge that a *prima facie* case of obviousness under 35 USC §103 has not been established.

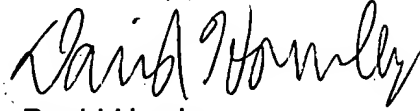
Further, claim 8 calls for the tips of the protrusions to have a width of from about 0.005 to 0.025 inches. Claim 9 calls for the rocking element to have a thickness of less than 0.200 inches. Claim 10 calls for the rocking element to have a thickness of from 0.050 to 0.125 inches. Claim 11 calls for the rocking element to have a thickness of from 0.080 to 0.100 inches. Claim 12 calls for the rocking element to have an overall diameter less than 1.000 inches. Claim 13 calls for the rocking element to have an overall diameter of from 0.500 to 0.700 inches. Claim 14 calls for the rocking element to have an overall diameter of from 0.550 to 0.650 inches. Neither Mark nor Birch teach or suggest any of these features. Accordingly, claims 8-14 are not obvious in view of these two references.

Claims 43 and 44 feature an oral care device having a rocking element with protrusions extending along the longitudinal axis of the oral care device. The protrusions include side surfaces that define an arc having a radius of curvature from about 0.150 to 0.175. Neither Mark nor Birch teach or suggest protrusions having side surfaces defining an arc that has a radius of curvature from about 0.150 to 0.175. Accordingly, Applicants assert that claims 43 and 44 are not obvious in view of these two references..

### **Conclusion**

Applicants assert that claims 1, 3, 7-17, 22-23, 43 and 44 are novel and unobvious over the art of record. Accordingly, Applicants request that the Board of Appeals reach this conclusion.

Respectfully submitted,



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## APPENDIX

1. An oral care device comprising  
a body defining a longitudinal axis having a head shaped for insertion into the oral cavity,  
and

a rocking element mounted on the head, the rocking element including a central portion  
and a plurality of protrusions extending radially from the central portion along the longitudinal  
axis of the body, wherein the protrusions taper from a relatively wide base to a relatively narrow  
tip and wherein the tips are shaped to penetrate the interproximal and subgingival regions of the  
oral cavity.

3. The oral care device of claim 1 further comprising tooth cleansing elements extending  
from a top surface of the head.

7. The oral care device of claim 1 wherein the tips have a width of less than 0.070.

8. The oral care device of claim 1 wherein the tips have a width of from about 0.005 to  
0.025 inches.

9. The oral care device of claim 1 wherein the rocking element has a thickness of less  
than 0.200 inches.

10. The oral care device of claim 1 wherein the rocking element has a thickness of from  
0.050 to 0.125 inches.

11. The oral care device of claim 1 wherein the rocking element has a thickness of from  
0.080 to 0.100 inches.

12. The oral care device of claim 1 wherein the rocking element has an overall diameter  
less than 1.000 inches.

13. The oral care device of claim 1 wherein the rocking element has an overall diameter  
of from 0.500 to 0.700 inches.

14. The oral care device of claim 1 wherein the rocking element has an overall diameter of from 0.550 to 0.650 inches.

15. The oral care device of claim 1 wherein the rocking element is formed of a material having a durometer reading of from about 20 to 90 Shore A.

16. The oral care device of claim 1 wherein the rocking element is formed of a material having a durometer reading of from about 40 to 80 Shore A.

17. The oral care device of claim 1 wherein the central portion further includes an opening therethrough sized to allow the rocking element to conform to a tooth's shape during use.

22. The oral care device of claim 1 wherein the rocking element further comprises a mounting element sized to mount into a hole in the head.

23. The oral care device of claim 1 further comprising a second rocking element.

43. The oral care device of claim 1, wherein the protrusions comprise side surfaces having a radius of curvature from about 0.150 to 0.175.

44. An oral care device comprising  
a body defining a longitudinal axis having a head shaped for insertion into the oral cavity,  
and

a rocking element mounted on the head, the rocking element including a central portion and a plurality of protrusions extending radially from the central portion along the longitudinal axis of the oral care device, wherein the protrusions comprise side surfaces that define an arc having a radius of curvature from about 0.150 to 0.175.